

OVERVIEW OF PATENT APPLICATION PROCESS

US Applications

Patent applications are received daily in the PTO mail center and at the walkup Customer Services Window currently located in the lobby of Crystal Plaza 2. Each envelope is stamped with the date received in the PTO and forwarded to the open/sort staff in the Office of Initial Patent Examination (OIPE). For applications received via the regular US mail, this receipt date becomes the official application filing date; for applications received via Express Mail, the official application filing date is the date the documents were deposited for Express Mail.

During the open/sort process, all mail is opened and the documents stamped with the PTO receipt date. For each new application, a serial number is assigned, date labels are applied to selected documents, and the documents are inserted into the appropriate application file jacket (folder). The application file is then forwarded for fee determination and recordation, selected documents are scanned, and a routing classification is assigned. Next a "formality review" is performed to determine that all statutory filing requirements have been met and the application is complete. It is during this stage that bibliographic data is entered into the PACE system and a filing receipt is generated and mailed to the applicant. The serial number is "initialized (i.e., activated in the PALM system) and the application is then placed for pickup by mail center personnel who deliver the file to the appropriate Examining Group (Tech Center). (An application which is deemed acceptable for granting of a filing date but is missing required documents is considered a "Missing Parts" application. Instead of a filing receipt, this applicant receives a Notice of Missing Parts and the application is retained in the Missing Parts File Room until the required documents are received in the PTO. At that point the application is forwarded for completion of formality review and issuance of a filing receipt after which it is forwarded to the appropriate Group.)

New applications are delivered to each Tech Center's mailroom where each application is "PALMed" in (i.e., PALM location information is updated) to that location. Each application is then delivered to the appropriate location for the particular Tech Center (e.g., a holding room, an SPE's office) following which it is reviewed to determine if drawings are present, the assigned classification is further refined (typically by a classifier or an SPE), and the case is assigned to an examiner's docket. (In some instances, where a case should be assigned for examination is questioned and the case is sent to another Art Unit or Group on a "transfer inquiry." These cases are also referred to as "dispute cases.") The assigned case is then delivered to the appropriate Tech Support Staff (TSS) Team where it is PALMed in and the TSS team docket the case to the examiner (i.e., examiner information is entered into the PALM record for that application). Next a TSS employee performs new case processing activities (i.e., formalities review and fee calculations are reviewed and verified); depending on the nature of any errors identified, corrections are either made by the TSS or are recorded on a form which is inserted into the application file for later processing by the examiner. The case is then delivered to central files where it is PALMed in and

filed and where it remains until retrieved by the examiner for examination.

It is important to note that throughout the life of a patent application, various papers arrive in the office which must be matched with the application file. These documents are processed through OIPE's open/sort and RAM functions and are forwarded to the appropriate Tech Center's mailroom where they are sorted, batched, and identified for application file retrieval (paper matching). "Paper matching" requires that all possible locations (e.g., central files, examiner office, TSS team, SPE's office) be searched and the case found, after which the paper is inserted in the file and the file given to the appropriate TSS team. The TSS then records the type of paper and its receipt date on the Contents side of the file jacket. Depending on the document received, the file is either given to the examiner or returned to Central Files for storage. If the document is an amendment, the TSS also must write the identified changes on the original application papers.

When an examiner is ready to begin working on an application, he/she either retrieves the file from central files or requests delivery of the file using an examiner file request form. The examiner will then review the application, search the prior art, and analyze the application's claim in order to make a patentability determination. An office action (i.e., official correspondence sent to the applicant) is prepared by the examiner then forwarded to the TSS who record the action on the Contents side of the file then perform the appropriate PALM transaction to give the examiner production credit. If necessary, the office action is forwarded for typing. If the office action cites references and they are present in the file, the application is forwarded for reference copying; after copying is completed or if no references are cited, the application is forwarded for mailing. Following completion of mailing, the file is returned to central files where it's PALMed in and filed. The application will remain in central files until the applicant's response is received or a specified time period (depending on the type of office action issued) ends. During the life of an application, multiple office actions may be issued by the examiner. In general, each office action is processed in the manner just described. Although other actions (e.g., appeals) are possible, the examiner's work on an application typically is completed when the application is allowed (i.e., determined to be patentable), rejected, or abandoned by the applicant.

PCT Application

The Patent Cooperation Treaty (PCT) is a multilateral treaty that was concluded in Washington in 1970. It is administered by the International Bureau (IB) of the World Intellectual Property Organization (WIPO), whose headquarters are in Geneva, Switzerland. PCT makes easy the acquisition of protection for invention where such protection is sought in any or all of the PCT contracting countries; currently there are 100 countries. Instead of filing separate patent applications in each country in which patent protection is desired, the PCT provides for the filing of one patent application (the international application) with effect in multiple countries.

All incoming PCT mail is received and processed by the PCT mailroom. Miscellaneous documents are sorted, stamped with the date the document

was received in the PTO, and delivered to a designated location. Documents with fees attached are forwarded for RAM processing. Many of the documents received in PCT are Article 20 papers (i.e., papers relating to applications filed elsewhere but whose applicant indicated they may file in the US). These papers are retained in PCT's file room in individual folders until they are either matched with an incoming application or a specified time period has passed.

Both international and national entry stage applications are received in PCT where they are assigned serial numbers and applications files are prepared (multiple files may be prepared for an international application). Fees are identified and recorded after which the application under goes a formality review similar to that identified above for US applications. Bibliographic data for new international applications is entered into PALM after which a number of standard forms are printed for inclusion in the application. Following completion of the formality review, copies of the application are made and forwarded to the IB and the International Search Authority (if other than the US), and copies of the forms are forwarded to the applicant. PCT applications are maintained in the PCT file room until they are pulled for review by an examiner. Bibliographic data for new national stage applications is entered into both PALM and PACE. Following mailing of a filing receipt to the applicant, the application is forwarded to the appropriate Tech Center where it is processed like all other US applications.